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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,565	01/02/2004	Li-Ching Lo	LOLI3003/EM	8780
23364	7590	09/26/2005	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314				LEITH, PATRICIA A
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/749,565	LO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patricia Leith	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 7/5/05.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date, _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 1-18 remain pending in the application.

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-8 in the reply filed on 7/5/05 is acknowledged. Claims 9-18 are thus hereby withdrawn from consideration as they are directed toward a non-elected invention.

Claims 1-8 were examined on their merits.

### ***Claim Objections***

Claims objected to because of the following informalities:

Claim 1 recites 'claims 1' which should properly read 'claim 1'.

Claim 4 recites 'claims 3' which should properly read 'claim 3'.

Claim 5 recites 'extracts according to claims 4' which should properly read 'extract according to claim 4'.

Claim 6 recites 'claims 1' which should properly read 'claim 1'.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 2, 4, 5, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states 'commminuted fruit of Fructus Ligustri Lucidi..., Rhizoma Polygonati.....'. It appears that the claim is stating that the fruit of all of these herbs are used. However, in light of the Specification, it appears that Applicant may mean only the fruit of Ligustri Lucidi and not the fruit of the other listed plants. Therefore, this language is ambiguous. In order to overcome this rejection, it is suggested, since 'Fructus Ligustri Lucidi' literally means Ligustri Lucidi fruit, that the claim be reworded to state 'by extracting commminuted Ligustri Lucidi....' in order to avoid confusion.

Claim 2 states 'may be'. This phrase renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 2 states 'selecting from a group consisting of methanol and ethanol as necessary'. First, 'selecting from a group consisting of' should properly read 'selected from the group consisting of' in order to conform to correct Markush group practice. Second, the phrase 'as necessary' is considered ambiguous. It is unclear if Applicant intends for the solvents to be used or not. Deletion of this phrase is suggested.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: how to use the silica gel. The extraction does not simply 'use' silica gel; the resulting extract is loaded onto a column containing silica gel, eluted and a resulting extract is collected from the elution. In order to overcome this rejection, it is suggested that the phrase 'by using silica gel' be more succinct.

Claim 5 recites 'the elution solution'. This phrase lacks antecedent basis in claim 4 because claim 4 did not recite 'elution solution'. Correction is necessary.

Claim 6 recites 'the dielectric constant less than 10'. This phrase lacks antecedent basis in that claim 1 did not recite 'dielectric constant'.

Claim 8 recites 'wherein said viruses...'. This phrase lacks antecedent basis in claim 1 in that claim 1 did not recite viruses. Because this claim does not appear to

pertain to claim 1, it was examined with regard to the prior art as if it recited only 'the herbal extract according to claim 1'.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Niikawa et al. (1993)

Niikawa et al. (1993) evaluated substances which inhibited the mutagenicity of benzo[a]pyrene in bacteria. Amongst several protocols, Niikawa et al. performed methanolic extracts of *Ligustrum lucidum* fruits, followed by an ether and *n*-hexane extraction (see 'Materials and Methods' p. 2 and 'Results and discussion', p. 4). It is noted that the *n*-hexane layer was evaporated which is considered a purification step because it removes unwanted solvent, thereby further purifying the analyte (see pp. 2-3 'Separation of inhibitory components in methanol extract').

In view of In re Sussman, 141 F. 2d 267, 60 U.S.P.Q. 538 (CCPA 1944), the claims are rejected under 35 U.S.C. 102 (b) as well as 35 U.S.C. 112, first and second paragraph, "that since the steps are the same, the results must inherently be the same unless they are due to conditions not recited in the claims."

Claims 1, 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Du et al. (1995).

Du et al. (1995) disclosed a method for purifying Oleanolic acid from Ligustrum lucidum (aka 'Ligustri Lucidi', aka privet) fruit comprising extraction of L.lucidum fruit by petroleum ether followed by extracting twice each with 1000ml of chloroform for 2 hours, evaporated, dissolved in ethanol and evaporated. Thus, Du et al. disclosed a low polarity solvent extract of *L. lucidi* fruit, as well as a purification step following the extraction step (e.g. followed by a ethanol extraction = further purification).

Claim 4 is free of the art.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Thursday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia Leith  
Primary Examiner  
Art Unit 1655

09/15/05

